

REMARKS

Claims 1 – 46 remain in the application and stand finally rejected. Claims 1, 14 – 17, 32 and 42 – 45 are amended by this proposed amendment. No new matter is added. Although this amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

The “examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.” MPEP §2164.04, last paragraph (emphasis original).

Claims 1 – 10, 14 – 17, 19 – 27, 32 – 40 and 42 – 45 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over published U.S. Patent Application No. 2004/0205209 to Wengrovitz et al. in view of U.S. Patent No. 7,020,460 to Sherman et al. Claims 11 – 13, 18, 19, 28 – 31, 41 and 46 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. and Sherman et al. in further view of published U.S. Patent Application No. 2005/0013421 to Chavez et al.

Responding to the applicants prior arguments, the Final Office Action (Final) asserts that Sherman teaches a buddy list in conjunction with a notification service that updates a list of active and enabled buddies for a user (column 9, lines 54-57). In addition, the mobile customer may utilize instant messaging on the telephone (column 10, lines 17-25). Sherman thus teaches the use of mobile IM with the use of a buddy list.

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However, “use of mobile IM with the use of a buddy list” is not what the claims recite. Claim 1 recites that “**full IM capability** is provided to said telephone set, full IM capability **including creating** a buddy list.” Lines 12 – 13 (emphasis added). This is not taught, shown or suggested by Sherman et al., Wengrovitz et al. or any reference of record.

By contrast, Sherman et al. teaches a “process by which a customer may provision a notification service when the notification application is implemented **through a browser**

application that resides on a server 126.” Col. 5, lines 44 – 47 (emphasis added). Sherman et al. teaches using the browser application in cooperation with, but not through, the Sherman et al. telephone 130. Fig. 4, col. 5, line 44 – col. 6, line 22; *and see*, col. 6, lines 29 (“The telephone 130 powers on ...”) – 37. “At step 414, the customer enters the telephone numbers and permission codes of other customers to be added to the customer’s notification list in response to prompting by the notification application. The notification application requests the customer, via the telephone communication area 202,” (*id*, lines 38 – 43) and numbers are added through the browser application, not through the telephone 130. Clearly, Sherman et al. teaches using the browser application in cooperation with the telephone communication area 202 of the telephone 130. Col. 6, line 38 – col. 7, line 27.

Therefore, Sherman et al. fails to add what is missing from Wengrovitz et al. Therefore also, the combination of Sherman et al. and Wengrovitz et al. fails to teach, suggest or result in an apparatus or method wherein a telephone set with a keypad having a fixed number of key buttons and a display has full IM capability including creating a buddy list, as recited by independent claims 1, 14, 32 and 42, as finally rejected. Finally, therefore, the combination of Sherman et al. and Wengrovitz et al. fails to result in the present invention as recited by independent claims 1, 14, 32 and 42, as finally rejected.

Moreover, claims 1, 14, 32 and 42 are amended by this proposed amendment to better recite that the IM service is in one protocol, while the recited telephone is in the other, which is a telephony application protocol. This is supported throughout the specification, e.g., at page 2, line 11 – page 3, line 5, and page 5, line 22 – page 6, line 30. Claims 15 – 17 and 43 – 45 are amended responsive to the amendment to claims 14 and 42. No new matter is added and this is neither taught or suggested by any reference of record. Entry of the amendment and consideration of the claims, as amended, is respectfully requested.

Further, as previously noted, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03. Therefore, the combination of Wengrovitz et al. and Sherman et al., fails to teach, suggest or result in the present invention as recited in dependent claims 2 – 10, 15 – 17, 19 – 27, 33 – 40 and 43 – 45, which depend from

claims 1, 14, 32 and 42. Reconsideration and withdrawal of the final rejection of claims 1 – 10, 14 – 17, 19 – 27, 32 – 40 and 42 – 45 under 35 U.S.C. §103(a) is respectfully requested.

Neither does Chavez et al. add what is missing Wengrovitz et al. and Sherman et al. to result in the present invention as recited in claims 1, 14, 32 and 42. Therefore, claims 11 – 13, 18, 19, 28 – 31, 41 and 46, which depend from claims 1, 14, 32 and 42, are not made obvious by the combination of Chavez et al. with Wengrovitz et al. and Sherman et al. Reconsideration and withdrawal of the final rejection of claims 11 – 13, 18, 19, 28 – 31, 41 and 46 under 35 U.S.C. §103(a) is respectfully requested.

Applicants again note that Wengrovitz et al. and Chavez et al. are published subsequent to the filing date of the present application. Again the applicants reserve the right, if necessary, to offer evidence of invention prior to one of more of these references being applied under 35 U.S.C. §103(a) through 35 U.S.C. §102(e). However, for reasons set forth above, such a showing is still believed to be unnecessary. Applicants continue to reserve the right to make such a showing, if necessary.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 46 under 35 U.S.C. §103(a) and allowance of the application to issue.

Applicants have previously noted that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

Amendment After Final
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(emphasis added). The applicants continue to believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone No. listed below for a telephonic or personal interview to discuss any other changes.

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Respectfully submitted,

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